

Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person is required to respond to a collection of information unless it displays a valid OMB control number.

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

1248-0571P

	Application Number 10/022,916-Conf. #002105	Filed December 20, 2001
--	---	----------------------------

	First Named Inventor Masaya NAGATA
--	---------------------------------------

Art Unit 2143	Examiner A. H. Bilgrami
------------------	----------------------------

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant /inventor.  
 assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b)  
is enclosed. (Form PTO/SB/96)

- attorney or agent of record.

Registration number \_\_\_\_\_

Terrell C. Birch

Typed or printed name

- attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. 19,382

(703) 205-8000

Telephone number

March 30, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

\*Total of 1 forms are submitted.



Docket No.: 1248-0571P  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Masaya NAGATA

Application No.: 10/022,916

Confirmation No.: 2105

Filed: December 20, 2001

Art Unit: 2143

For: SERVICE MANAGEMENT METHOD,  
SERVICE MANAGEMENT PROGRAM, AND  
INFORMATION RECORDING MEDIUM  
RECORDING THE PROGRAM

Examiner: A. H. Bilgrami

**STATEMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests reconsideration and withdrawal of the rejections contained in the Office Action dated January 30, 2006.

**REJECTIONS BASED ON MOTOYAMA**

Independent claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Motoyama. Claim 6 requires a service management method managing an application program made up of a combination of a plurality of functions. The method includes detecting that a specific function is selected or performed and updating a management file which records usage conditions of the plurality of functions to distinguish detected functions from undetected functions. Claim 6 further requires that the functions be grouped into at least a first level and a second level and that at least one function in the first level is associated with at least one function in the second level. Claim 6 further requires that at least one function in the first level is identified as used only if all functions in the second level that are associated with the at least one function are identified as used.

Motoyama in no manner shows or suggests functions grouped into a first level and a second level. In fact, Motoyama monitors the use of applications and does not mention monitoring the use of functions in an application as required by claim 6. Motoyama therefore in no manner shows or suggests functions, much less functions grouped into first and second levels as required by claim 6.

Claim 6 further requires that at least one function in the first level be identified as used only if all functions in the second level that are associated with the at least one function are identified as used. The Office Action indicates that this limitation is shown at column 12, lines 6-67. However, these lines merely describe detecting the use of certain software applications. Motoyama in no manner suggests functions in one level being associated with functions in another level as required by claim 6, much less identifying a function in one level as used only if all functions of a second level associated with the at least one function are used.

The Office Action seems to indicate that the above limitations are inherent in Motoyama. However, the Office Action has not shown that these features are “necessarily present” in Motoyama as is required to support a rejection based on inherency. MPEP 2112 (IV). The feature of “identifying a function in one level as used only if all functions of the second level associated with the at least one function are used” in particular is not shown or suggested by the art of record, and the portion of Motoyama cited in the Office Action in no manner shows or suggests this limitation. Claim 6 is submitted to distinguish over Motoyama for at least this reason.

Independent claims 9, 15, 16, 20 and 21 also require that functions be grouped into a first level and a second level, that at least one function in the first level be associated with at least one function in the second level, and that functions in one level be identified as used only if all functions of the second level associated with the at least one function are used. These claims are submitted to distinguish over Motoyama for at least the same reasons as claim 6.

#### REJECTIONS BASED ON MOTOYAMA AND HORVITZ

Claim 1 is rejected as being unpatentable over Motoyama in view of Horvitz. A proper motivation for combining Motoyama and Horvitz has not been provided, and even if these

references could be combined, the result would not be the invention required by claim 1. Each of these points is addressed below.

The Office Action indicates that the reason for combining the references is shown in “studies of the use of models for reasoning about the intensions of people” mentioned at Horvitz, column 1, lines 49-65. These models and studies are not described at all in Horvitz and in no manner suggest the combination proposed by the examiner. It is therefore submitted that a motivation for combining the references has not been identified, that a *prima facie* case of obviousness has not been presented, and that claim 1 (and claims 2-21 which are also rejected based on a combination of Motoyama and Horvitz) is allowable over the references of record.

The Office Action includes the statement: “The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference” and cites *In re Bozek*, 163 U.S.P.Q. 545 (CCPA 1969) for support. This language suggests that no motivation for combining references is needed to support a rejection under 35 U.S.C. 103(a). The Federal Circuit critically commented on the *Bozek* case in *In re Lee*, 61 U.S.P.Q. 2d 1430, 1435 (Fed. Cir. 2002), opining: “Nor does Bozek, after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence.” A motivation must be provided in order to combine references, see MPEP 2143.01 and the cases cited therein. No motivation has been identified and no evidence has been presented to show that the motivation comes from “common knowledge.” Thus, if the present rejections are based on the assertion that no motivation for combining references needs to be identified, the rejections are traversed as not being in accordance with applicable law. Claims 1-21, all of which are rejected based on a combination of Motoyama and Horvitz, are therefore submitted to be allowable over the art of record.

Even if the references could be properly combined, the result would not be the invention required by claim 1. Claim 1 requires steps of 1) checking usage conditions of a plurality of functions to determine which functions have been used less than a predetermined number of times, and 2) making a computer carry out notification and promotion processing to promote a user to use a function from among the functions which have been determined to have been used

less than a predetermined number of times. Neither reference discloses at least a step of checking usage conditions of a plurality of functions to determine which functions have been used less than a predetermined number of times.

The Office Action acknowledges that this step is not shown in Motoyama and cites to column 23, line 61, to column 24, line 23 to show this feature in Horvitz. These columns of Horvitz, however, merely discuss displaying a help screen when a user might need assistance. Types of assistance might include formatting help and spell checking help. There is no indication in Horvitz that formatting commands or spell checking commands have been used less than a predetermined number of times as claimed. This combination of references, even if proper, would not show or suggest the invention required by claim 1.

Claim 3 also requires a step of checking usage conditions of a plurality of functions. In addition, claim 3 requires a step of receiving content from a service provider relating to a function that is used less than a predetermined number of times. No such step of receiving content is shown or suggested by Motoyama or Horvitz. The Office Action indicates that the aforementioned “previous studies” recited at column 1, lines 49-65, show this limitation. However, the mention of previous studies in no manner shows the limitation of receiving content from a service provider as claimed. Claim 3 distinguishes over these references for at least this reason. Claims 13 and 18 also require receiving content from a service provider and are submitted to be allowable for the same reasons as claim 3.

Claim 4 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama and Horvitz. However, claim 4 is not specifically mentioned in the body of the Office Action. Furthermore, the limitations of claim 4, relating to notification based on content, for example, are not addressed in the Office Action. These limitations are not shown or suggested by the art of record. It is therefore respectfully submitted that the Office Action has not presented a *prima facie* case of obviousness in connection with claim 4, and that claim 4 is allowable over the art of record.

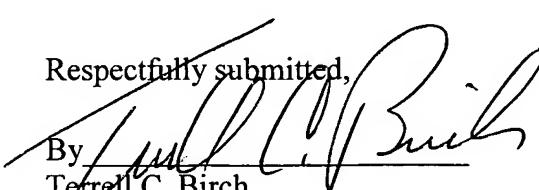
Claim 5 requires a step of receiving usage conditions from a device via a network. This feature is also not shown or suggested by the references of record. The Office Action indicates that this feature is shown in Motoyama at column 4, lines 56-61. However, these lines merely

mention that devices may communicate with a remote monitoring device via a network. They in no manner suggest receiving usage conditions from a device via a network as required by claim 5. Claim 5, and claims 14 and 19 which include similar limitations, are submitted to be allowable over the art of record for at least these reasons.

Reconsideration and allowance of claims 1-21 is earnestly solicited.

Dated: March 30, 2006

Respectfully submitted,

By   
Terrell C. Birch  
Registration No.: 19,382

Scott T. Wakeman  
Registration No.: 37,750  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorneys for Applicant